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EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,721

Applicant(s)

GAO, TAO SHI

Examiner

C. Melissa Koslow

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RM #13

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% of electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material, a first and second colorant, a thickener and a magnetic material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a first and second colorant, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, colorants, thickeners and magnetic materials in any amounts, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. The specification does

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not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The claims recite a magnetic dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material. This encompasses compositions comprising any bulk material, thickeners and magnetic materials in any amounts and any amount of a benzo oxazole fluorescent whitener, as long as the final product is a dispersion. However, the specification only teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese. Such a limited disclosure does not support the breadth of the instant claims.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed composition is not taught or suggested by the specification. Line 24 on page 2 through line 2 on page 3 teaches a magnetic dispersion medium comprising liquid paraffin, 1.5-3 wt% silica, 1.5-3 wt% titania, 0.001-0.005 wt% of a benzo oxazole fluorescent whitener and 13-20 wt% electrical steel powder which contains up to 17 wt% manganese, where the steel powder has a particle size of less than 100 microns. This teaching does not support the claimed materials, where the amounts are not given and the composition is not limited to that disclosed in the specification.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-10, "dispension" should be "dispersion". Claims 1 and 10 are indefinite since it is unclear what is meant by "bulk material".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ikeda et al.

This reference teaches a magnetic dispersion comprising a thickener, a liquid bulk material, such as liquid paraffin, and magnetic particles, where each end of the particles is coated with a different color (examples). Thus the taught material comprising two colorants. The reference clearly teaches the claimed composition.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chabay.

This reference teaches a magnetic dispersion medium comprising a liquid bulk material, a magnetic material and thickener and two colorants, where the first colorant are flow indicator particles which are titanium oxide coated mica particles and the second colorant are colored particles, such as glitter. The reference clearly teaches the claimed composition.

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Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Murata et al.

Examples 10 and 12 teach a magnetic dispersion medium comprising a liquid bulk material, a magnetic material and thickener and two colorants. Example 10 teaches one of the colorants is titania and example 12 teaches the thickener is silica. The reference clearly teaches the claimed composition.

Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-122577.

The translation for this reference teaches a magnetic dispersion medium comprising a liquid paraffin bulk material; titania particles, which is a colorant; silica particles, which is a thickener; and magnetic particles, such as iron particles. The taught iron particles are free of manganese and thus the reference teaches claim 5. The term "up to" includes 0 as a lower limit. *In re Mochel* 176 USPQ 194 (CCPA 1972). The reference teaches the claimed composition.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-122577.

As stated above, this reference teaches the claimed dispersion. Paragraph 0015 teaches the magnetic particles have a particle size in the range of 5-200 microns. This size range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re*

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Malagari 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed composition.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al.

As stated above, this reference teaches the claimed composition of a bulk material, a thickener, magnetic particles and two colorants. The bulk material can be liquid paraffin and the thickener can be silica (examples). The magnetic particles can be iron (col. 6, line 28). The taught iron particles are free of manganese and thus the reference teaches claim 5. The term "up to" includes 0 as a lower limit. *In re Mochel* 176 USPQ 194 (CCPA 1972). Column 5, lines 44-46 and the examples teach the composition can contain two colorants and that one of the colorant can be titania. Column 7, lines 20-22 teach the magnetic particles have a particle size in the range of 5-200 microns. This size range overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk

January 14, 2003



C. Melissa Koslow
Primary Examiner
Tech. Center 1700